

REMARKS

This Application has been carefully reviewed in light of the Office Action mailed December 9, 2004. At the time of the Office Action, Claims 1-11 and 16-19 were pending in this Application. Claims 1-11, 16, 17 and 19 were rejected, and Claim 18 was objected to. Claims 12-15 were previously cancelled without prejudice or disclaimer. Claims 1, 9, 10, 16, and 19 have been amended to further define various features of Applicant's invention. Applicant respectfully requests reconsideration and favorable action in this case.

Priority

Applicant encloses a certified copy of German Application DE 101 01 091.5 filed January 11, 2001.

Rejections under 35 U.S.C. §112

Claims 9 was rejected by the Examiner under 35 U.S.C. §112, second paragraph, as being indefinite and failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. Applicant amends Claim 9 to overcome this rejection.

Rejections under 35 U.S.C. §103

Claims 1-3, 5, 10-11, 16, and 19 were rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent Application Publication 2002/0088304 filed by Michael D. Thorum ("Thorum") in view of U.S. Patent 6,160,708 issued to Josef Loibl et al. ("Loibl"). Applicant respectfully traverses and submits the now claimed invention is patentably distinct over these references.

Claims 4, 6, 7 and 9 were rejected under 35 U.S.C. §103(a) as being unpatentable over Thorum in view of Loibl as applied to Claim 1 above, and further in view of U.S. Patent 6,164,160 issued to Roy S. Nassar ("Nassar"). Applicant respectfully traverses and submits the now claimed invention is patentably distinct over these references.

Claim 8 was rejected under 35 U.S.C. §103(a) as being unpatentable over Thorum in view of Loibl, in further view of Nassar as applied to Claim 4 above, and further in view of Clamp. Applicant respectfully traverses and submits the now claimed invention is patentably distinct over these references.

In order to establish a *prima facie* case of obviousness, the references cited by the Examiner must disclose all claimed limitations. *In re Royka*, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974). Furthermore, according to § 2143 of the Manual of Patent Examining Procedure, to establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991). Here, it is respectfully submitted that the Examiner has not established a *prima facie* case of obviousness. A combination of the cited references, which Applicant does not concede is proper, does not yield each and every limitation of the claimed embodiment of the invention. The Examiner cites Thorum for allegedly teaching and disclosing "a hydraulic motor vehicle gearbox control device comprising a hydraulic distribution plate 30 having channels therethrough for the distribution of hydraulic fluid to cool circuit electronics 34 of an electronic control unit 16 housed on said plate, said plate having electric conductors embedded therein, and/or metallized on the surface thereof (Fig. 7B). (emphasis added). Applicant respectfully disagrees with the Examiner's conclusion as underlined above. A review of Fig. 7B of Thorum reveals hydraulic distribution plate 30, i.e., "said plate" does not have any electrical conductors embedded therein and/or metallized thereon. See also Figure 1. The presently claimed embodiment of the invention requires that the plate having the channels therethrough must also have electrical conductors embedded therein and/or metallized thereon. Plate 30 of Thorum simply has another plate 28 mounted thereon. Compare Thorum's configuration with Figure 3 of the present application. As shown in

Figure 3, hydraulic distribution plate 1 includes channels 13a and 13b which lead to and from chamber 12a. Further, embedded in and/or metallized on to plate 1 are electrical conductors 9. See left hand side of Figure 3 wherein flexible circuit board 8 contacts conductors 9 on plate 1. A quick review of Thorum et al. reveals that while they disclose a plate with a channel running therethrough and a flexible circuit board 34, they do not teach and/or disclose any conductors whatsoever, much less conductors embedded in and/or metallize on plate 30, i.e., the same plate having the hydraulic channels as required by the present claim. And Loibl et al. certainly do not disclose such a system either. Consequently, Applicant requests withdrawal of the rejection and favorable action.

Allowable Subject Matter

Applicant appreciates Examiner's consideration and indication that Claim 18 would be allowable if rewritten in independent form to include all of the limitations of the base claim and any intervening claims. Applicant submits new Claim 16 incorporating the elements of allowable Claim 18, intervening Claim 17, and base Claim 16. Applicant submits new Claims 20-26 dependent on allowable Claim 16. Applicant submits new Claim 16 and its dependents, i.e., Claims 19-26, are in condition for allowance and requests favorable action.

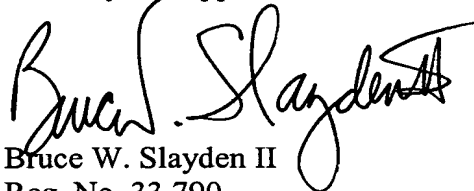
CONCLUSION

Applicant has now made an earnest effort to place this case in condition for allowance in light of the amendments and remarks set forth above. Applicant respectfully requests reconsideration of Claims 1-16 as amended and new Claims 20-26.

Applicant believes there are no fees due at this time, however, the Commissioner is hereby authorized to charge any fees to Deposit Account No. 50-2148 of Baker Botts L.L.P. in order to effectuate this filing.

If there are any matters concerning this Application that may be cleared up in a telephone conversation, please contact Applicant's attorney at 512.322.2606.

Respectfully submitted,
BAKER BOTTS L.L.P.
Attorney for Applicant


Bruce W. Slayden II
Reg. No. 33,790

SEND CORRESPONDENCE TO:
BAKER BOTTS L.L.P.

CUSTOMER ACCOUNT NO. **31625**
512.322.2606
512.322.8306 (fax)

Date: 3/3/2005